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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/473,383	12/28/1999	DOMINIC J. MOREA	06920-0120	9919

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EXAMINER

O CONNOR, GERALD J

ART UNIT

PAPER NUMBER

3627

DATE MAILED: 03/11/2003

8

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/473,383

Applicant(s)

Morea et al.

Examiner

O'Connor

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on November 8, 2002 (Amdt "A")
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15, 17-20, 22-24, and 26-44 is/are pending in the application.
- 4a) Of the above, claim(s) none is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15, 17-20, 22-24, and 26-44 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on Nov 8, 2002 is: a) ☒ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other: _____

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DETAILED ACTION

Preliminary Remarks

1. This Office action responds to the amendment and arguments filed by applicant on November 8, 2002 (Paper N^o 7) in reply to the Office action mailed August 8, 2002.
2. The amendment of claim 9, the cancellation of claims 16, 21, and 25, and the addition of claims 26-44 by applicant in Paper N^o 7, are hereby acknowledged.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

4. Apparatus claims 26-44 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Zirkel (US 6,135,349). Note that, in making this rejection, the extensively recited functional language has been deemed merely intended usage of the invention, hence, afforded little patentable weight. The actual structural elements recited by the claims include merely "structure," followed by an extensive description of intended usage that the recited element of

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“structure” is envisaged to perform, for example, “to receive information from the applicant completing an application for the merchant account.”

The manner of operating a device does not differentiate apparatus claims from the prior art. A claim containing a “recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus” if the prior art apparatus teaches all the *structural* limitations of the claim. *Ex parte Masham*, 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987) (The preamble of claim 1 recited that the apparatus was “for mixing flowing developer material” and the body of the claim recited “means for mixing ..., said mixing means being stationary and completely submerged in the developer material”. The claim was rejected over a reference which taught all the structural limitations of the claim for the intended use of mixing flowing developer. However, the mixer was only partially submerged in the developer material. The Board held that the amount of submersion is immaterial to the structure of the mixer and thus the claim was properly rejected.).

Apparatus claims must be structurally distinguishable from the prior art. Claims directed to apparatus must be distinguished from the prior art in terms of structure rather than function. *In re Danly*, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959). “[A]pparatus claims cover what a device *is*, not what a device *does*.” *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990) (emphasis in original).

For further exposition regarding the lack of relevance, hence, patentable weight, of functional language in apparatus claims, refer to MPEP §2114.

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Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-15, 17-20, and 22-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over the admitted prior art, as described in the written specification, in view of Zirkel (US 6,135,349).

As described by applicant, the essence of the instant invention is a method of using the Internet, by means of appropriate computer hardware and software, to perform an otherwise conventional, well known method for activating a merchant account, accomplishing the same result as had heretofore been accomplished via manual means.

However, Zirkel discloses a similar method of activating a merchant account, and the method of Zirkel indeed includes activating the merchant account by means of the Internet, using appropriate computer hardware and software.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have modified the conventional manual method of activating a merchant account described by applicant, so as to allow a merchant to activate a merchant account by means of the Internet, using appropriate computer hardware and software, in accordance with the teachings of

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Zirkel, in order to improve the efficiency of the merchant account application/ordering process, by having the merchant input all of the required application information, thereby saving time by reducing the amount of manual effort required on the part of the account provider, and also allowing the merchant to apply at any time convenient for the merchant, independent of the hours of the account provider, thereby increasing sales/profits for the account provider.

Response to Arguments

7. Applicant's arguments filed Nov. 8, 2002 have been fully considered but are not persuasive.

8. Regarding the argument with respect to the rejection of the method claims as obvious under 35 U.S.C. 103, applicant's arguments fail to point out any specific features that are not comprised by the applied prior art. Applicant's disagreement that there is any "essence of the invention standard," is noted, but the argument is irrelevant because applicant fails to point out any specific way in which the instant invention differs from the applied prior art. The known prior art, as explained by applicant from page 2, line 14, to page 4, line 12, of the written specification, comprises a manual process for activating a merchant account. According to applicant, this known manual process "has worked well" (page 4, line 3), but has the disadvantage of taking "several days or weeks to complete" (page 4, line 4). Applicant's invention merely provides a means of performing the known manual method electronically, by means of the Internet, thereby improving the turnaround time required to perform the method. This aspect of automation, using the Internet,

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is the only difference between the known prior and the instant invention. As Zirkel teaches using the Internet to electronically perform a similar method, the instant invention is therefore obvious over the known manual process, in view of Zirkel.

9. Regarding the argument with respect to various elements of the method claims that Zirkel allegedly fails to show, the argument is irrelevant, as the rejection does not allege that any of the argued features are shown in Zirkel. Zirkel is relied upon in the obviousness rejection merely for its teaching of using appropriate computer hardware and software in order to practice a method similar in nature to that of the instant invention by means of the Internet.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to the disclosure.

11. Applicant's amendment necessitated any new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the

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date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

12. PLEASE TAKE NOTICE that the Group Art Unit number to which this application is assigned is not "2876." The correct Group Art Unit number is 3627.

13. PLEASE TAKE NOTICE that the name of the examiner to which this application is assigned is not "Albert J. Gagliardi". The correct examiner name is *G. J. O'Connor*.

14. Any inquiry concerning this communication, or earlier communications, should be directed to the examiner, Jerry O'Connor, whose telephone number is (703) 305-1525, and whose facsimile number is (703) 746-3976.

GJOC

March 7, 2003

Michael Cuff 3/10/03
MICHAEL CUFF
PRIMARY EXAMINER